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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,956	03/31/2004	Christine Mcunicer	237565US0	4881
22850	7590	11/15/2007	EXAMINER	
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			FRAZIER, BARBARA S	
ART UNIT		PAPER NUMBER		
4173				
NOTIFICATION DATE		DELIVERY MODE		
11/15/2007		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
oblonpat@oblon.com  
jgardner@oblon.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/812,956	MEUNIER, CHRISTINE	
Examiner	Art Unit		
Barbara Frazier	4173		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 15 August 2007 and 19 October 2007.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-11, 13-15 and 17-24 is/are pending in the application.  
4a) Of the above claim(s) 20, 22 and 23 is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-11, 13-15, 17-19, 21 and 24 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All    b)  Some \* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date *3 sheets*.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.  
5)  Notice of Informal Patent Application  
6)  Other: \_\_\_\_.

**DETAILED ACTION**

1. Applicant's election with traverse of Group I, claims 1-22 in the reply filed on 8/15/07 is acknowledged. The traversal is on the ground(s) that a) the search for both groups would occur in the same classes/subclasses, and thus no burden would be placed on the Office in searching and/or examining all claims together, and b) at minimum, claim 23 should be rejoined in the application upon indication of allowable subject matter. This is not found persuasive because a serious burden does exist in searching both groups together; there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Furthermore, as noted in the restriction requirement mailed 7/16/07, if the product claims are subsequently found allowable, the withdrawn process claims that depend or otherwise require

all the limitations of the allowable product claim will be considered for rejoinder (for details, see the restriction requirement mailed 7/16/07, paragraph 4).

The requirement is still deemed proper and is therefore made FINAL.

2. Claim 23 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 8/15/07.

Applicant's election with traverse of the species of (1) water dispersed in cyclohexasiloxane, (2) PEG-6 caprylic/capric glyceride, (3) ethanol, (4) the silicone emulsifier of formula I, particularly the mixture of oxyethylenated/oxypropylenated polydimethylsiloxane 18EO/PO (for example, the commercial product DC 5225C), and (5) caffeine, in the reply filed on 8/15/07 is acknowledged. The traversal is on the ground(s) that a) the reason underlying the designation by the Office of all five identifies species is not explained in sufficient detail or by example, and as such represents only a conclusion, particularly in view of the fact that the identifies species are related by operation and/or effect, and b) the search for all of these types of compounds would occur in substantially the same classes/subclasses, and thus no burden would be placed on the Office in searching and/or examining all claims together. This is not found persuasive because a) sufficient reasoning and examples have already been provided in the Office action mailed 7/16/07 (see page 4, line 14 – page 5, line 2 of the Office action named above), and b) the species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the

species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

The requirement is still deemed proper and is therefore made FINAL.

The election of species requirement, with respect to the addition of a cyclomethicone only (i.e. claims 7-11), has been withdrawn; therefore, claims 7-11 will be examined with the elected species.

3. Claims 20 and 22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 8/15/07.

***Priority***

4. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear if the phrase "comprising ethanol" is defining the "C2-C3 monoalcohol" of claim 1, or if it is an additional monoalcohol present in the composition.

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Applicant Claims
2. Determining the scope and contents of the prior art.
3. Ascertaining the differences between the prior art and the claims at issue, and resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

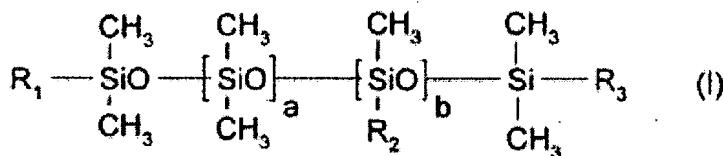
This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-11, 13-15, 17, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al., US Patent 6,007,799, in view of Lukenbach et al., US Patent 7,262,158.

*Applicant Claims*

The claimed invention is a composition as defined in claim 1:

1. (Currently Amended): A composition comprising:
  - (a) at least one aqueous phase dispersed in a fatty phase,
  - (b) at least one glyceride of a C<sub>6</sub> to C<sub>22</sub> fatty acid or of a mixture of C<sub>6</sub> to C<sub>22</sub> fatty acids, which is polyoxyethylenated and/or polyoxypropylenated,
  - (c) at least one C<sub>2</sub>-C<sub>3</sub> monoalcohol, wherein the monoalcohol is present in an amount of between [[20%]] 10% and 50% by weight relative to the total weight of the composition,
  - (d) at least one silicone emulsifier of formula (I):



in which:

a is an integer of 0 to 400,

b is an integer of 0 to 50,

a and b cannot simultaneously be equal to 0,

R<sub>1</sub>, R<sub>2</sub> and R<sub>3</sub> independently represent a C<sub>1</sub>-C<sub>6</sub> alkyl radical or the radical -(CH<sub>2</sub>)<sub>x</sub>-(OCH<sub>2</sub>CH<sub>2</sub>)<sub>y</sub>-(OCH<sub>2</sub>CH<sub>2</sub>CH<sub>2</sub>)<sub>z</sub>-OR<sub>4</sub>, at least one of the radicals R<sub>1</sub>, R<sub>2</sub> and R<sub>3</sub> being -(CH<sub>2</sub>)<sub>x</sub>-(OCH<sub>2</sub>CH<sub>2</sub>)<sub>y</sub>-(OCH<sub>2</sub>CH<sub>2</sub>CH<sub>2</sub>)<sub>z</sub>-OR<sub>4</sub>,

R<sub>4</sub> represents a hydrogen atom, a C<sub>1</sub>-C<sub>3</sub> alkyl radical or a C<sub>2</sub>-C<sub>4</sub> acyl radical,

x is an integer ranging from 0 to 6,

y is an integer ranging from 1 to 30, and

z is an integer ranging from 0 to 30.

***Determination of the Scope and Content of the Prior Art (MPEP §2141.01)***

Lee et al. disclose a cosmetic composition in the form of a water-in-oil emulsion (i.e., an aqueous phase dispersed in a fatty phase; see abstract) comprising a silicone oil phase, preferably a cyclomethicone having 4 to 6 siloxane groups (from which cyclohexasiloxane would be immediately apparent; see col. 12, lines 11-14), ethanol (col. 11, line 11), and a silicone emulsifier containing dimethicone copolyol (the silicone emulsifier in DC 5225C; see col. 12, lines 37 – 41). The composition also includes a polar species that may be an ester derivative of a polyhydric alcohol (col. 11, lines 1-5). The composition may also have cosmetically active agents (col. 13, lines 25-27).

***Ascertainment of the Difference Between Scope the Prior Art and the Claims (MPEP §2141.012)***

Lee et al. differ from the prior art because they do not specifically teach that the ester derivative of the polyhydric alcohol is PEG-6 caprylic/capric glyceride.

***Finding of Prima Facie Obviousness Rational and Motivation (MPEP §2142-2143)***

However, Lukenbach et al. disclose a cosmetic composition which may be an water-in-oil emulsion (col. 7, lines 34-35) having a water-dispersible component which, most preferably, is polyethylene glycol-6 caprylic/capric glyceride (col. 4, lines 9-10 and 21-24; also see Example 9, columns 26 and 27). The compositions of Lukenbach et al. may also have a silicone oil (col. 4, lines 5-6) and a silicone emulsifier, such as dimethicone copolyol (col. 14, line 55).

One skilled in the art would recognize that the addition of a known water-dispersible component such as PEG-6 caprylic/capric glyceride to a water-in-oil emulsion would be advantageous, since such an addition would allow the aqueous phase to disperse more easily in the fatty phase, and thus result in a more stabilized emulsion.

Since both compositions are directed to cosmetic compositions of water-in-oil emulsions having silicone oil and silicone emulsifier, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to select the water-dispersible PEG-6 caprylic/capric glyceride of Lukenbach et al. as the polyhydric alcohol ester derivative of Lee et al. in order to arrive at the claimed invention, with a reasonable expectation of success.

Regarding the amount of monoalcohol present (claims 1 and 24), Lee et al. teach that coupling agent (i.e., ethanol) is present in an amount of from about 10% to about 30% by weight (col. 11, lines 57-60); the amount is encompassed by Applicant's amount of 10-50% by weight (see claim 1).

Regarding the amount of silicone emulsifier (claim 6), Lee et al. disclose that the mixture of cyclomethicone and dimethicone copolyol is 4-20% by weight (col. 12, lines 49-52). Since the amount of dimethicone copolyol in DC 3225C (exemplified by Lee et al.) is 10% (as taught on page 8 of Applicant's specification), the amount of silicone emulsifier in Lee et al. would be 0.4-2% by weight relative to the total weight of the composition; this is encompassed by Applicant's amount, which is 0.1-5% by weight.

Regarding the presence of cyclomethicone (claims 7 and 8), Lee et al. disclose the composition has cyclomethicones of formula  $((CH_3)_2SiO)_x$  where  $x=4-6$ ; this is encompassed by Applicant's cyclomethicones of formula (III) having 3 to 8 siloxane groups (claim 7).

Regarding the amount of cyclomethicone (claim 9), Lee et al. state that the cyclomethicones are present up to 18%, preferably 4-12% by weight (col. 12, lines 9-12). This amount overlaps the amount of cyclomethicone in the claimed invention, and a person having ordinary skill in the art would be able to select the amount of cyclomethicone as a matter of routine optimization.

Regarding the ratio between silicone emulsifier and cyclomethicone (claims 10 and 11), Lee et al. cite the use of DC3225C, which has a silicone emulsifier/cyclomethicone/water ratio of 10/88/2, as cited in Applicant's claim 11.

Regarding the amount of fatty acid (claim 15), Lukenbach et al. disclose that the water-dispersible component is present in an amount of from about 10 percent to about 20 percent (col. 3, lines 60-61). This appears to be comparable to the amounts claimed by Applicants (i.e., 0.1 – 10% by weight; see claim 15), especially given that the prior art uses the flexible modifier “about”. In any case, it would have been obvious to determine workable and/or optimal amounts of pigment per the reasoning of well-established precedent, such as In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). (Holding that “[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.”)

8. Claims 18, 19, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al. and Lukenbach et al. as applied to claims 1-11, 13-15, 17, and 24 above, and further in view of Nadaud et al., US Patent 5,567,426.

***Applicant Claims***

Claims 18, 19, and 21 are drawn to the composition according to claim 1, further comprising at least one lipolytic active agent, such as caffeine.

***Determination of the Scope and Content of the Prior Art (MPEP §2141.01)***

Lee et al. and Lukenbach et al. disclose a cosmetic composition as described above (see paragraph 7). Lee et al. teach that the composition may be an emollient composition or a sunscreen composition (col. 8, lines 3-4), and can also have “additional cosmetically active ingredients” (col. 13, lines 25-27).

***Ascertainment of the Difference Between Scope the Prior Art and the Claims (MPEP §2141.012)***

Lee et al. and Lukenbach et al. differ from the prior art because they do not specifically teach that the “cosmetically active ingredient” may be caffeine.

***Finding of Prima Facie Obviousness Rational and Motivation (MPEP §2142-2143)***

However, Nadaud et al. disclose cosmetic compositions in the form of emulsions comprising water, silicone oil and silicone emulsifier which are emollient compositions (col. 10, lines 51-58), or sunscreen agents (col. 11, lines 1-3), and where slimming products can also be obtained, having active substances such as caffeine (col. 11, lines 18-23). Thus, one skilled in the art would recognize that caffeine could also be an acceptable ingredient in the water/silicone emulsions of Lee et al., and if one desired formulating a slimming product one would have been motivated to select caffeine as the cosmetically active ingredient. The selection of a specific ingredient to perform the desired function is *prima facie* obvious.

Since all of the inventions are drawn to cosmetic compositions comprising water and silicone emulsions, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to select caffeine as the "additional cosmetically active ingredient" of Lee et al. in order to arrive at the claimed invention, with a reasonable expectation of success.

Regarding the amount of lipolytically active agent present (claim 21), Nadaud et al. disclose caffeine as being present at 0.4% by weight relative to the total weight of the composition (see Example 1, columns 11 and 12). This is encompassed by Applicant's amount of 0.1 to 10% by weight (claim 21).

***Examiner's Remarks***

9. In order to clarify the subject matter of claim 6, it is suggested that Applicants amend the claim so that only one range for the amount of silicone emulsifier present (i.e., 0.1% - 5% by weight, or between 0.5% and 3% by weight) is recited.

***Pertinent Prior Art***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Siciliano, US Patent 5,490,982, discloses oil and water microemulsions formulated with fragrance (col. 1, lines 6-9), wherein the clarity is improved in the presence of PEG-8 caprylic/capric glycerides (col 5, lines 40-41).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara Frazier whose telephone number is (571)270-3496. The examiner can normally be reached on Monday-Thursday 8am-4pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel can be reached on (571)272-0718, or Cecilia Tsang can be reached on (571)272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BSF

*Sharmila Gollamudi Landau*

SHARMILA GOLLAMUDI LANDAU  
PRIMARY EXAMINER